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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,992	02/25/2004	Jiacheng Zhou	DM-6964C (BMS-2595)	6780

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EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,992

Applicant(s)

ZHOU ET AL.

Examiner

EBENEZER SACKY

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to: See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claim

The finality of the previous office action mailed on 01/06/05 has been withdrawn.

This amendment filed 03/08/05 is in response to the office action mailed on 01/06/05.

Claim 10 is pending. Claims 11 and 12 have been cancelled.

After Final Practice

The indicated allowability of claim 10 is withdrawn in view of further prosecution deemed necessary in the present case.

An error in a search strategy previously submitted to CAS searchers has been noted. Upon correction, many newly discovered references have been obtained.

Exemplary are those applied below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by:

(1) Bowie et al., Electron Impact Studies, Skeletal-Rearrangement Fragments In The Mass Spectra Of Alkyl And Aryl Isoxazoles, "Australian J. Chem.", 1969, 22, pp. 563-575".

Art Unit: 1626

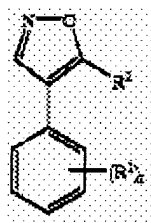
(2) Royer et al., Recherches sur le benzofuranne.XI.-Formation d'isoxazoles par action de l'hydroxylamine sur les derives 3-carboyles du benzofuranne, Memoires Presentes A la Societe Chimique.

(3) Giuseppe, Conjugation in unsatd. Systems containing heteroatoms- (I) phenylisoxazoles.

(4) Yasuda Hiroyuki, "Syntheses of 4,5-disubstituted isoxazoles and their cleavage reaction with Na ethoxide- (II) application to the determination of attack point of ethyl formate on unsym, ketones.

(5) Yasuo et al., JP 58148858.

Applicants claim a benzoisoxazole compound of structural formula (IV), wherein



the substituents are as defined in claim 10

Bowie et al., discloses a compound identical to the instantly claimed compound. See compound number (XIV), Table on page 570.

Royer et al., discloses a compound identical instantly claimed compound. See compound (II), page 1746.

Giuseppe discloses a compound identical to instantly claimed compound. See the attached abstract, RN 2439-92-1.

Hiroyuki discloses compounds identical to the instantly claimed compound. See the attached abstract, RN's 23253-49-8 and 103987-29-7.

Art Unit: 1626

Yasuo et al., discloses a pharmaceutical compound identical to the instantly claimed compound. See the attached abstract, RN 88408-51-9 and the Japanese Patent, the source of the compound, pages 5 and 6.

In view of the anticipatory art applied above, to advance the prosecution, applicants are requested to elect a single species and present a claim to such to determine patentability should generic claim be found not allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

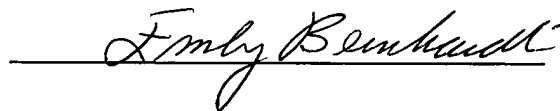
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is

(571) 272-1600.

EOS

March 29, 2005



**EMILY BERNHARDT
PRIMARY EXAMINER
GROUP 1600**